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Mailed: August 17, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Winsor Grain, Inc.
v.
Turf-Seed, Inc.

Opposition No. 91162188

Richard O. Bartz, Esq. for Winsor Grain, Inc.

Arthur L. Whinston of Klanquist Sparkman, LLP for Turf-Seed,
Inc.

Before Bucher, Holtzman and Cataldo, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

On August 8, 2003, applicant, Turf-Seed, Inc., filed an application to register the mark CALIFORNIA GOLD ("CALIFORNIA" disclaimed) based upon an allegation of a bona fide intention to use the mark in commerce for "grass seed" in International Class 31.¹

¹ Application Serial No. 76538911.

Registration has been opposed by Winsor Grain, Inc. ("Winsor"). As grounds for opposition, opposer asserts that it has used the mark CALIFORNIA GOLD for its agricultural seeds since a date prior to the August 8, 2003 filing date of the involved intent-to-use application and that applicant's mark CALIFORNIA GOLD when used on applicant's goods so resembles opposer's mark CALIFORNIA GOLD for agricultural seeds as to be likely to cause confusion.

Applicant's answer consists of a general denial of the allegations in the opposition.

The record includes the pleadings and the file of the involved application. In addition, opposer has filed a notice of reliance on the following:

(1) A certified copy of application Serial No. 76594623 filed by Winsor Grain, Inc. (opposer herein) on June 3, 2004, for the mark CALIFORNIA GOLD for goods identified as "agricultural seeds for planting, namely, wheat, barley, Sudan grass and alfalfa seeds." The application includes a disclaimer of "CALIFORNIA" and asserts dates of first use and first in commerce on August 2, 1992.

(2) An Office action dated January 14, 2005 citing the application involved herein as a potential bar to registration of opposer's mark, and refusing registration of the mark as

primarily geographically descriptive under Section 2(e)(2) of the Trademark Act.

(3) A "true and correct copy," according to opposer, of opposer's response to the Office action which includes argument by Winsor that the mark is not geographically descriptive of the goods; and a declaration of Winsor's president and owner, Mr. William Cook, who attests to, inter alia, the first use of the mark CALIFORNIA GOLD in 1992, Winsor's market share for the identified goods, and annual sales under the mark. The declaration is accompanied by exhibits including a copy of Winsor's prior registration (No. 1826536) of the mark CALIFORNIA GOLD for "agricultural seeds for planting; namely, wheat, barley, Sudan grass and alfalfa seeds" which, according to Mr. Cook, was "inadvertently cancelled due to failure to comply with the use and fee requirements of the U.S. Trademark Law."²

Opposer did not take any testimony. Applicant did not take any testimony or submit any other evidence in its own behalf. Only opposer filed a brief. Neither party requested an oral hearing.

Opposer argues in its brief that "applicant's failure to present testimony to support a bona fide intention to use the

² Office records show that the registration was cancelled under Section 8 of the Trademark Act on April 28, 2001.

trademark in commerce results in Applicant's abandonment of the mark CALIFORNIA GOLD." Brief at 5. Opposer argues with respect to the issue of likelihood of confusion that opposer has used the mark since August 1992; that applicant's and opposer's marks, both CALIFORNIA GOLD are identical in all respects; and that the respective goods are related and could be marketed in the same trade channels to the same potential purchasers.

The claim of abandonment was neither pleaded by opposer nor tried by the parties, and therefore it will not be considered. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). See also TBMP §314 (2d ed. rev. 2004) and cases cited therein. Moreover, opposer did not present any evidence on this claim. The burden is on opposer, as plaintiff in the proceeding, to come forward with proof of the essential elements of its claims, regardless of whether applicant offers any evidence.

As to opposer's pleaded claim of likelihood of confusion, we must first address the admissibility of the documents offered into the record by opposer's notice of reliance. The certified copy of opposer's application and the Office action are admissible by notice of reliance as official records under Trademark Rule 2.122(e). That rule requires submission of "the official record or a copy thereof whose authenticity is

established under the Federal Rules of Evidence." The document that opposer has identified as a "true and correct" copy of a response to the Office action appears to be opposer's own file copy of the document and does not even reflect that it was received by the Office. Consequently this document does not qualify as an official record, as contemplated by Rule 2.122(e), and it is therefore not admissible by notice of reliance. See *Hard Rock Cafe International (USA) Inc. v. Elsea*, 56 USPQ2d 1504 (TTAB 2000); and *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992).

However, even assuming that the response, like the application, does qualify as an official record, such documents are of record only for what they show on their face. The statements made in these documents, including the dates of use asserted in the application and the statements made in Mr. Cook's declaration, are not admissible for their truth, and do not constitute evidence in opposer's behalf. See *Sunbeam Corp. v. Battle Creek Equipment Co.*, 216 USPQ 1101, 1102 n.3 (TTAB 1982) ("statements made in an application for registration do not constitute admissible evidence in inter partes trademark proceedings"; Section 2(f) affidavit in application not admissible). See also Trademark Rule 2.122(b)(2);³ British

³ The rule provides, in relevant part, "The allegation in an application for registration, or in a registration, of a date of use

Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197, 1200 (TTAB 1993) (affidavits submitted during prosecution of application not in evidence on behalf of applicant), aff'd, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); and TBMP §704.04, supra, and cases cited therein. To the extent that opposer intended Mr. Cook's declaration to constitute testimony, it is improperly introduced. In the absence of an agreement by the parties, an affidavit or declaration of a witness is not admissible under a notice of reliance. Trademark Rule 2.123(b). See also Trademark Rule 2.123(1) (evidence not obtained and filed in compliance with the rules of practice will not be considered by the Board).

Thus, neither the dates of use alleged in the application nor the statements made in Mr. Cook's declaration can serve opposer's purpose of proving the date of first use of opposer's mark. See TBMP §704.07, supra.

On the basis of the evidence that is properly of record, opposer has demonstrated its standing, that is, its real interest in the proceeding, by the submission of an Office action showing that the subject application has been cited as a potential bar to the registration of opposer's mark. See Cunningham v. Laser Golf Corp., 222 F.3d 942, 55 USPQ2d 1842

is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence."

(Fed. Cir. 2000); and, e.g., *The Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990).

However, opposer has failed to properly introduce any evidence that its mark CALIFORNIA GOLD was used prior to the August 8, 2003 filing date of the involved application.⁴ Accordingly, inasmuch as we find that opposer has not established its priority, opposer cannot prevail on its claim of likelihood of confusion.

Decision: The opposition is dismissed.

⁴ In addition, opposer's now cancelled registration is not evidence of anything except that it issued. See TBMP §704.03(b)(1)(A), *supra*, and cases cited therein. See also *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002). Any benefits conferred by the registration, including the evidentiary presumptions afforded by Section 7(b) of the Trademark Act were lost when the registration was cancelled. See, e.g., *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46 (CCPA 1973).